

REMARKS

An interview was granted by the Examiner and such interview took place on August 4, 2004. The courtesies extended by the Examiner at the Interview are gratefully acknowledged. A record has been made of the interview, and such record will be further supplemented by the remarks herein.

As stated during the interview, the references are quite different in their actual teachings from the present invention. The Examiner and Applicant's attorney reviewed a draft amended claim 67. Due to some uncertainty about whether the draft claim 67 clearly recited the sequence of actions being discussed, claims 67-75 have been cancelled, without prejudice, in favor of new claims 76-93. Independent claim 76 has been drafted to reflect the sequence of main operations in the flow chart in Fig. 2.

In claim 76, the term "discount" has been expressed as purchase incentive. For example, a manufacturer's purchase incentive includes at least one of: a purchase price discount, a free upgrade or a free accessory, with a purchase price discount being more specifically claimed in dependent claim 83. Support for the three types of purchase incentives is found in paragraph [0047] and is repeated in paragraphs [0070] and [0085].

In claim 76, the term "personal contact information" is used, as being more descriptive than "buyer information," meaning a name and address, or an e-mail address as disclosed in paras. [0041] and [0043] of the specification. This information will be used to communicate the voucher to the prospective customer.

The invention as disclosed in Fig. 2 provides a method for:

- 1) allowing the prospective customer to shop on the Internet for products before requesting personal contact information from the prospective customer and a postal address code (Fig. 2, Steps 2-5 vs. Step 6, claim 76, lines 8-19),

2) requesting the prospective customer to supply the customer's personal contact information and zip code in exchange for receiving a purchase incentive voucher (Fig. 2, Step 6, claim 76 lines 20-26);

3) receiving the customer's personal contact information and zip code; (Fig. 2, Step 7, claim 76, lines 27-30);

4) the website making a selection of a single reseller from among more than one possible reseller (Fig. 2, Step 8, claim 76, lines 31-38; specification, para. [0045]);

5) generating a voucher having a time limit for redemption and having a producer's purchase incentive on the purchase of the selected product at only one selected reseller; (Fig. 2, Steps 9 and 10, claim 76, lines 39-42); and

6) communicating the voucher to the customer directly or to the single reseller which requires that the customer visit that reseller within a specific time to claim the benefit of the purchase incentive (Fig. 2, Step 10, claim 76, lines 43-45.)

The invention is further distinguished from the prior art in claim 77 by reciting that the prospective customer's control over selection of the reseller is limited to the customer entering the product selection and entering the postal address code (Fig. 2, Step 8, specification, para. [0045])

The invention is further distinguished from the prior art in claim 78 by reciting that the reseller (the seller in the references) is selected by the website in a sequence in which a purchase price of the product is not displayed to the prospective customer. Support for this limitation is found in paragraph [0009] of the specification.

The invention is further distinguished from the prior art in claim 79 by reciting the selection of the one product, the entry of personal contact information and communication of the voucher occurs in only one access to the website. Support for this is found in step 1 of Fig. 2.

The invention is further distinguished from the prior art in claim 80 by reciting that the voucher is communicated for only one product for each access of the website. Support for this is provided by Fig. 2 and paragraphs [0029]-[0051] of the specification.

In claim 81, the pre-defined marketing territory is an exclusive marketing territory assigned to the reseller by the producer of the selected product. Support for this is found in paragraphs [0006]-[0012] of the specification and in amended paragraph [0045].

The invention is further distinguished from the prior art in claim 82 by reciting that the selection of the reseller does not utilize pre-stored demographic data or direct customer selection through a screen display. Support for this is provided by Fig. 2 and paragraphs [0029]-[0051] of the specification.

Claim 83 is not deemed novel in and of itself, but further defines the purchase incentive as a purchase price discount of the selected product.

Claim 84 is not deemed novel in and of itself, but further defines the personal contact information as including an e-mail address of the prospective customer.

Claims 85-93 parallel claims 76-84 with the exception that selection of a producer from a group of producers through a screen display is not a limitation. This is intended to claim the single producer site which otherwise uses the method of the present invention as explained herein. Support for skipping steps 2 and 3 in Fig. 2 is provided by paragraph [0033].

THE CONTENT OF THE APPLIED REFERENCES,
NOTABLY STEWART AND SCROGGIE

Applicant submitted an Information Disclosure Statement at the interview including Stewart, U.S. Pat. Nos. 6,326,918; 6,414,635, 6,452,498; 6,697,018 and 6,759,960. Although not prior art, Applicant also submitted representative screen displays and cites www.wayport.com as

helping to illustrate the operation of the Stewart patents and www.supermarkets.com as helping illustrate the operation of the Scroggie patents. The disclosures of these patents should be reviewed in the context of these sites, as they are consistent with the disclosures in those patents.

The applied Stewart reference is entitled "Geographic-based Communications Service." The geography being talked about there is the GPS (global positioning system) location of the customer in terms of longitude and latitude. There can be several GPS access points where the customer can connect wirelessly to the system.

The GPS points of Stewart are not used to select a single service provider; they are used to locate the customer. The customer then selects a destination such as an airport or a downtown area. The network then displays to the user all of the service providers in that user-selected airport or downtown area that fits the criteria of the user's demographic data (pre-loaded customer profile data). And, this is also for the purpose of communicating orders by the Wi-Fi portion of the Wayport network to these service providers, as shown by Screens 1-5 of www.wayport.com. submitted in the Information Disclosure Statement.

Wayport is not freely available on the Internet, it a monthly fee subscription network for both users and service providers (see. www.wayport.com). If the service providers have not signed up to the Wayport network, they will not be shown to the customer. For example, in the screen displays, no Holiday Inns are part of the network in Wisconsin (Screen 5), even though there many Holiday Inns in the state.

There is only an incidental disclosure of purchaser incentives in one of its ten or so examples. In these targeted advertising promotions discussed in col. 27, an offer of a discount on a product is sent to the user in an unsolicited fashion. At most, the user's pre-stored demographic information may show some interest in the product. They are like Internet pop-up ads.

In Stewart, the geographic location of the buyer (GPS point) is of primary concern for communicating wirelessly

with the buyer. Multiple GPS locations might apply to a buyer. The use of GPS points in Stewart is not a matter of channeling buyers to one reseller vs. another as reseller is defined in the current application. Service providers are predetermined in Stewart by pre-stored customer preference information, called "demographic information," and or they by selected by the customer, after a group has been offered using the GPS point.

As further evidence of this, Applicant points to the claims of Stewart.

Every single one of Stewart's 49 claims is limited to selecting the service based on 1) the GPS location and 2) the demographic information. The GPS location is not the determining factor in selecting service providers such as Hertz or Avis, it only tells you the nearest Hertz or Avis outlet and it may tell you both or you may have pre-selected with your membership information.

In Stewart, the term "demographic information" is intended to include, but is not limited to, information such as: full name, address, contact information such as telephone number and email address, daily schedule, family members, hobbies, past purchases, spending habits, buying preferences, hotel preferences, restaurant preferences, rental car preferences, banking habits, memberships (e.g., American Airlines Advantage Program, Hertz Number One Club Gold), associations, and other information. The term "past activities" may be used synonymously with the term "demographic information". (Stewart, col. 10, lines 8-22; and col. 11, lines 21-31).

If the customer is a Hertz Gold customer, the customer has preselected Hertz before the customer ever logs onto the system through the GPS point. If the customer has specified Hilton hotels or Holiday Inn hotels, the customer has selected the hotel provider before the customer ever logs onto the system through the GPS point.

Stewart actually relies on three items to generate a response to the user: 1) a broad range of pre-stored demographic information 2) a GPS location and 3) an order

for services such as described at col. 20, lines 20 lines 27-54.

Scroggie also uses pre-stored customer purchase history information to select sellers (See Scroggie Fig. 19, block 406, and col. 12). In addition, Scroggie does not use the zip code to select a single seller; it only narrows the territory of a group of sellers, and the user then selects the seller directly. This was demonstrated at the interview on www.supermarkets.com.

In Scroggie, the primary purpose is to provide a grocery list of user coupons, however, these are granted on a regional basis and the purchaser selects the final seller directly as discussed in the Scroggie patents, but perhaps best illustrated by the screen displays from the www.supermarkets.com website submitted with the prior amendment and further made of record in the Information Disclosure Statement.

Scroggie also selects multiple providers within a zip code area, which is a data entry in a very first step (Fig. 2 log-in; www.supermarkets.com, Screen 1) to narrow the choice of grocery stores and drug stores to one zip code area before the customer makes the actual selection.

Thus, even one of ordinary skill in the art cannot simply substitute the zip codes and printed voucher of Scroggie into the system of Stewart to arrive at the claimed invention because even combining Stewart and Scroggie does not provide a zip code selection criterion to select a single reseller in the way it operates in the claimed invention.

Scroggie and Stewart rely on 1) customer selection of the selling franchise (brand name) by pre-loaded customer preferences or customer profile information; 2) direct selection by the customer of the destination zip region, destination airport or destination city center (downtown) to narrow the field to a group of service providers and 3) final selection of a service outlet through the direct selection by the customer.

In neither of the applied references is location used to pick a single seller from more than one possible seller. Geography is only used to narrow the field of sellers and the customer directly picks from this field of sellers. Insofar as the rejection of claim 67 was based on the premise that Stewart used geography to pick a single seller from a group of sellers, solely based on GPS points, this is believed to be incorrect.

The references do not -- during an incentive voucher sequence -- have the user first shop for a product, second enter personal contact information and a zip code, and third have a website computer system to make a selection of a single reseller of a product, and fourth only then communicate the purchase incentive to the prospective customer.

This is carried through in the claim by the following two sequencing recitations 1):

"after receiving said only one product selection from said prospective customer and before displaying any amount of any purchase discount to the prospective customer,

"providing a screen display to the prospective customer which requests the prospective customer to enter personal contact information and a postal address code."

and 2)

"after the website receiving the only one product selection and the personal contact information and the postal address code from the prospective customer,

"the website selecting only one reseller from a plurality of available resellers ...; and

"the website then generating a voucher having a time limit for redemption and having a producer's purchase incentive on the purchase of the only one selected product at the only one selected reseller."

It is further emphasized that the incentive voucher is not disclosed to the user until the user has committed to input of the product selection data and the personal contact information and the postal address code in contrast to unsolicited advertising offers.

During the interview, the Examiner mentioned that the inputting of personal contact information was a step known in the art. Applicant responds that in this case the inputting of personal contact information functions as a request for a voucher and is not requested of the user until the user has shown sufficient interest in the product by selecting a product. This is not suggested in the prior art.

The other references of record, such as Cupps, are cumulative of Scroggie and Stewart. Both Scroggie and Cupps use a log-in procedure in which the user enters his name and ID or password which cross-reference to pre-stored information. These are systems designed to attract the casual Web surfer customer as does the present invention.

THE NONOBVIOUSNESS OF THE
CLAIMED DIFFERENCES FROM THE PRIOR ART

During the interview, the Examiner requested that even assuming the claimed invention provided differences from the applied prior art, that the nonobviousness of the differences from the prior art be addressed.

First, the differences will be summarized.

In claims 76 and 85

The user shops for products before seeing prices or the amounts of the incentives unlike Scroggie, unlike Stewart's targeted advertising and unlike many other websites in the art.

Second, personal contact information and a zip code are requested after a single product has been selected during the shopping phase and before the selection of the reseller. In the references, different sequences are employed to do different things.

Third, the reseller is selected from a plurality of resellers by comparing a zip code to a pre-defined marketing territory. Stewart and Scroggie cannot do this because they typically have more than one reseller in a zip code territory. The present invention is advantageous for

resellers having territories equal to or larger than one zip code area.

The differences are nonobvious, because only the inventor has recognized the problem in the art of providing Internet delivery of purchaser incentive vouchers where dealers have assigned marketing territories equal to or larger than one zip code. Most of the prior art either doesn't know about this type of distribution network, or doesn't offer the type of incentive vouchers offered by the invention, due to the different nature of their businesses.

Second, only the inventor has recognized a method that achieves marketing results in letting shoppers shop without requiring large amounts of information, and then intriguing shoppers with the offer of a discount if they will input their contact information, and then further intriguing shoppers by offering a purchase incentive if they will visit a specific reseller.

The invention also selects that reseller in an unobtrusive manner. Because the prior art neither discusses nor understands these differences or the reasons for them, the differences are nonobvious. In support of the improved marketing results of using the claimed invention, the Applicant submits a further signed declaration of the inventor discussing the marketing benefits of the invention, besides simply offering the purchasers a discount.

In addition, the invention provides the following differences highlighted in the dependent claims.

First, the entire process takes place in one website access unlike Stewart and Scroggie which require additional accesses to register or provide demographic information (customer preferences).

Second, the process does not utilize user selection of sellers either directly or through pre-stored customer profile information as in Stewart and Scroggie.

Third, the price of the product is not disclosed to the user even when the voucher is communicated as in many websites currently in use. This heightens consumer interest in visiting the reseller.

Fourth, only one voucher for one product is provided in each access to the website.

The invention requires a minimum amount of information to avoid deterring prospective customers from participating.

REPLY TO PARAGRAPHS OF THE OFFICE ACTION
CONCERNING SUPPORT IN THE SPECIFICATION

In the last Office Action, a rejection in paragraph 3 under 35 U.S.C. §132 was made for entry of new matter. The new matter was identified as the following language in paragraph [0045]:

The structured computer program 130 selects the reseller ~~or resellers~~ that sells the product in memory 140 selected by the buyer 100 and that has the territory that includes, or is are located closest to, the buyer 100 based on the zip code in memory 140 entered by the buyer.

The Examiner's reasoning that this is new matter seems to be that it was not stated this way in the application as originally filed. Applicant agrees that was not stated in paragraph [0045], however, Applicant is merely supplying the inherent result of incorporating the definition of reseller from paragraph [0006].

Under 35 U.S.C. § 112, paragraph one, the application must contain sufficient disclosure, expressly or inherently, to make it clear to one skilled in the art that patentee was in possession of the claimed subject matter at the time of filing the application. However, it is not necessary that the language of the claims be described in haec verbis or ipsis verbis (Latin for "in the same words") in the specification in order for the description requirement to be satisfied nor does such a rule limit amendment of the description. *In re Edwards*, 568 F.2d 1349, 196 USPQ 465, 467 (CCPA 1978); *In re Driscoll*, 562 F.2d 1245, 195 USPQ 434, 438 (CCPA 1977); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279, 284-285 (CCPA 1973).

Words added to the specification are not new matter where they are: 1) rephrasing of a passage, 2) an obvious error 3) a description of a something that inherently

functions in the manner described or 4) constitute an example though not described in the specification can be arrived at without undue experimentation. MPEP §§2163, 2164.

The Examiner's test of literalness (*in haec verbis*) for judging new matter and for judging support in the specification is too strict. The amendments to the specification meet the tests set forth by the Courts and the U.S. Patent and Trademark Office.

The modification of "closest to" language in paragraph [0045] simply recognizes that the resellers have territories as described in both the Background of the Invention and the Summary of the Invention. Paragraph [0006] defines "resellers" as follows:

[0006] A further disadvantage is encountered when the distribution system of the producer assigns geographic areas ("territories") to each reseller. In these types of systems, each reseller is given primary responsibility for the market within their territory and typically spends much time and money advertising, marketing, and promoting the producer's product with their assigned territory."

Paragraph [0012] under "Summary of the Invention" goes on to say:

Finally, it provides the voucher containing the incentive to the buyer through electronic means, confirming that the benefit will be received that will be received if the buyer visits the reseller in the appropriate geographic or product area." (That means the one assigned by the producer.)

As stated in paragraph [0010] the objects of the invention are:

1. The invention will direct the buyer to a specific reseller for redemption.

2. The invention will eliminate the possibility of resellers selling to buyers outside their assigned territories. (The invention could not accomplish this if assigned exclusive marketing territories were new matter.)

3. The invention will allow producers to channel buyers to the location appropriate for the purchase based on a distribution structure (not merely for the convenience of the buyer).

The statement being amended in paragraph [0045] was an oversimplification which inadvertently omitted the territory of the reseller that is measured against the zip code, but this was disclosed in the Background and Summary of the Invention. It is apparent from the entire disclosure that it is the territory of the resellers herein that is measured against the zip code and not a store address.

Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection based on new matter.

In paragraph 5 of the Office Action, a similar rejection is made concerning the same language in the claims as not supported by the specification.

Under 35 U.S.C. @ 112, paragraph one, the application must contain sufficient disclosure, expressly or inherently, to make it clear to one skilled in the art that patentee was in possession of the claimed subject matter at the time of filing the application. However, it is not necessary that the language of the claims be described in haec verbis (Latin for "in the same words") in the specification in order for the description requirement to be satisfied nor does such a rule limit amendment of the description. *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Driscoll*, 562 F.2d 1245, 195 USPQ 434 (CCPA 1977); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973).

Applicant would cite the same passages as cited above in response to the new matter rejection.

Paragraph [0006] defines "resellers" as follows:

[0006] A further disadvantage is encountered when the distribution system of the producer assigns geographic areas ("territories") to each reseller. In these types of systems, each reseller is given primary responsibility for the market within their territory and typically spends much

time and money advertising, marketing, and promoting the producer's product with their assigned territory."

In addition paragraph 0006 further discloses, that if the product isn't available in northern Illinois for the reasons described at paragraph [0006] last two lines, or some other reason, the Illinois customers will be directed to Wisconsin, even though there is a reseller in Illinois. This discloses that the size of the reseller territories are typically larger than one zip code.

Paragraph [0012] under "Summary of the Invention" goes on to say:

"Finally, it provides the voucher containing the incentive to the buyer through electronic means, confirming that the benefit will be received that will be received if the buyer visits the reseller in the appropriate geographic or product area." (That means the one assigned by the producer.)

As stated in paragraph [0010] the objects of the invention are:

1. The invention will direct the buyer to a specific reseller for redemption.
2. The invention will eliminate the possibility of resellers selling to buyers outside their assigned territories. (The invention could not accomplish this if assigned exclusive marketing territories were not disclosed in the application.)
3. The invention will allow producers to channel buyers to the location appropriate for the purchase based on a distribution structure (not merely convenience of the buyer).

It is reasonable and legally proper for the definition of "resellers" (used in the claims) to be included in discussing the problem in the prior art and in the summary of the invention. It is not required by law to be in the summary of the invention or in the detailed description. The Federal Circuit has said on occasions too numerous to cite herein that claims must be interpreted in view of the specification. The specification, according to 37 C.F.R.

1.77(b), includes the Background of the Invention as well as the Summary of the Invention.

The Federal Circuit has said many times in construing claims, that the specification of which the claims are a part, teaches about the problems solved by the claimed invention, the way the claimed invention solves the problems and the prior art that relates to the invention. These teachings provide valuable context for the meaning of claim language. *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F. 3d 1547, 1554, 42 USPQ2d 1737, 1741 (Fed. Cir. 1997); *Laitram Corp. v. Morehouse Industries, Inc.* 143 F.3d 1456; 46 USPQ2d 1609 (Fed. Cir. 1998). Furthermore, when a patentee has used a claim term throughout the entire patent specification, in a manner consistent with only a single meaning, he has defined the term by "implication." *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1268, 1271, 59 USPQ 1865 (Fed. Cir. 2001)

It is clear that the use of the term "reseller" in this application is meant to include the resellers with the primary or exclusive advertising rights for that territory to which all customers in the territory will be channeled to, provided that reseller has the product the customer has selected. The resellers talked about in paragraph [0006] are the same resellers talked about in paragraph [0010] and the same resellers talked about throughout the detailed description.

Therefore, it also requested that the rejection in paragraph 5 under 35 U.S.C. § 112, paragraph one, be reconsidered and withdrawn.

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CONCLUSION

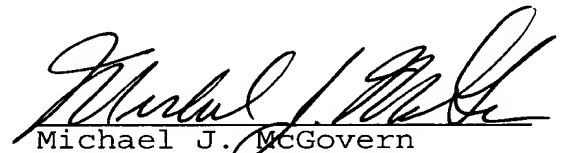
During the Interview, Applicant's attorney inadvertently omitted signing the fee sheet for the Information Disclosure Statement, so a signed fee sheet is submitted herewith.

No other fee is believed to be due, but if any fee is deemed to be due or any credit due, please the Commissioner is authorized to charge Quarles & Brady deposit account no. 17-0055.

In view of the Amendment and Remarks, reconsideration of the patent application is respectfully requested. After the amendment, claims 76-93 are now pending and a Notice of Allowance for these claims is earnestly solicited.

Respectfully submitted,

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